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August 17, 2004

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Art Unit 2623

Commissioner for Patents PO Box 1450 Alexandria, VA 22313-1450

Re:

U.S. Utility Patent Application

Application No. 10/725,541; Filed: December 3, 2003

System and Method for Generating a Preview Display in a Print

Capturing System Using a Non-Planar Prism

Inventors:

McClurg et al.

Our Ref:

1823.082000A

Sir:

Transmitted herewith for appropriate action are the following documents:

- 1. Information Disclosure Statement (IDS);
- 2. Form PTO-1449 (9 sheets) listing the cited documents;
- Copies of the five(5) cited documents; and 3.
- 4. One (1) return postcard.

It is respectfully requested that the attached postcard be stamped with the date of filing of these documents, and that it be returned to our courier. In the event that extensions of time are necessary to prevent abandonment of this patent application, then such extensions of time are hereby petitioned.

The U.S. Patent and Trademark Office is hereby authorized to charge any fee deficiency, or credit any overpayment, to our Deposit Account No. 19-0036.

Respectfully submitted,

STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.

Jason D. Eisenberg

Attorney for Applicants

Registration No. 43,447 Spenge / Kesseler, Goldstein & Fox P.L.C.: 1100 New York Avenue, NW: Washington, DC 20005: 202.371.2600 f 202.371.3540; DOC www.skgf.com



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

McClurg et al.

Appl. No.: 10/725,541

Filed: December 3, 2003

For: System and Method for Generating

a Preview Display in a Print Capturing System Using a Non-

Planar Prism

Confirmation No.: 3188

Art Unit: 2623

Examiner: A. Au

Atty. Docket: 1823.082000A

Information Disclosure Statement

Commissioner for Patents PO Box 1450 Alexandria, VA 22313-1450

Sir:

Listed on accompanying Form PTO-1449 are documents that may be considered material to the examination of this application, in compliance with the duty of disclosure requirements of 37 C.F.R. §§ 1.56, 1.97 and 1.98.

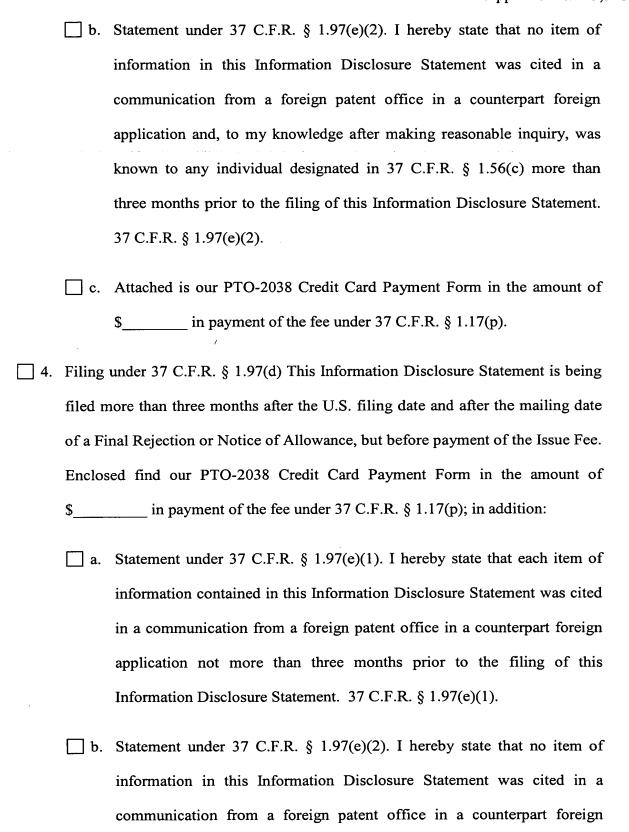
Applicants have listed publication dates on the attached PTO-1449 based on information presently available to the undersigned. However, the listed publication dates should not be construed as an admission that the information was actually published on the date indicated.

Applicants reserve the right to establish the patentability of the claimed invention over any of the information provided herewith, and/or to prove that this information may not be prior art, and/or to prove that this information may not be enabling for the teachings purportedly offered.

This statement should not be construed as a representation that a search has been made, or that information more material to the examination of the present patent application does not exist. The Examiner is specifically requested not to rely solely on the material submitted herewith.

Applicants have checked the appropriate boxes below.

- ☐ 1. Statement under 37 C.F.R. 1.704(d). Each item of information contained in this
 Information Disclosure Statement was cited in a communication from a foreign
 patent office in a counterpart application and this communication was not
 received by any individual designated in 37 C.F.R. § 1.56(c) more than thirty
 days prior to the filing of this information disclosure statement.
- 3. Filing under 37 C.F.R. § 1.97(c). This Information Disclosure Statement is being filed more than three months after the U.S. filing date AND after the mailing date of the first Office Action on the merits, but before the mailing date of a Final Rejection, or Notice of Allowance, or an action that otherwise closes prosecution in the application.
 - ☐ a. Statement under 37 C.F.R. § 1.97(e)(1). I hereby state that each item of information contained in this Information Disclosure Statement was first cited in any communication from a foreign patent office in a counterpart foreign application not more than three months prior to the filing of this Information Disclosure Statement. 37 C.F.R. § 1.97(e)(1).



application and, to my knowledge after making reasonable inquiry, was known to any individual designated in 37 C.F.R. § 1.56(c) more than three months prior to the filing of this Information Disclosure Statement. 37 C.F.R. § 1.97(e)(2).

⊠ 5.	Documents AH1, AB3, AB4, and AD5 were cited in a search report in a
	counterpart PCT application. A copy of the search report is enclosed as
	document AN1 for the convenience of the Examiner.
⊠ 6.	A concise explanation of the relevance of the non-English language document
	AK1 appears below:
	Document AK1 (JP 3-161884) appears to describe a finger image input device.
	An English language abstract of document AK1 is enclosed as document AO1.
⊠ 7.	Copies of documents AJ1, AK1, AN1, AO1, and AP1 are submitted herewith.
8.	Copies of the documents were cited by or submitted to the Office in an IDS that
	complies with 37 C.F.R. § 1.98(a)-(c) in Application No, filed
	, which is relied upon for an earlier filing date under 35 U.S.C.
	§ 120. Thus, copies of these documents are not attached. 37 C.F.R. § 1.98(d).
2 9.	No copies of U.S. patents and patent application publications cited on the
	attached Form PTO-1449 are submitted in accordance with 1276 OG 55 because
	this application was filed after June 30, 2003.
<u> </u>	It is expected that the examiner will review the prosecution and cited art in the
	parent application no(s) in accordance with MPEP 2001.06(b), and

indicate in the next communication from the office that the art cited in the earlier prosecution history has been reviewed in connection with the present application.

It is respectfully requested that the Examiner initial and return a copy of the enclosed PTO-1449, and indicate in the official file wrapper of this patent application that the documents have been considered.

The U.S. Patent and Trademark Office is hereby authorized to charge any fee deficiency, or credit any overpayment, to our Deposit Account No. 19-0036.

Respectfully submitted,

STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.

Jason D. Eisenberg

Attorney for Applicants Registration No. 43,447

Date:

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(202) 371-2600

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Page 1 of 9 ATTY, DOCKET NO. APPLICATION NO. AUG 1 7 2004 1823.082000A 10/725,541 **FORM PTO-1449 INVENTORS** McClurg et al. INFORMATION DISCLOSURE **ART UNIT** FILING DATE TE TRADEN December 3, 2003 2623 **U.S. PATENT DOCUMENTS EXAMINER DOCUMENT NUMBER** DATE CLASS SUB-CLASS **FILING DATE** INITIAL NAME 2,184,858 12/1939 Goodman AA1 AB1 3,054,854 09/1962 Neasham AC1 3,282,152 11/1966 Myer 08/1967 AD1 3.333.502 Flanagan 3,511,571 05/1970 Ogle AE1 AF1 3,648,240 03/1972 Jacoby et al. 02/1973 Caulfield et al. AG1 3,716,301 AH1 3,765,018 10/1973 Heard et al. AI1 3,804,524 04/1974 Jocoy et al. **FOREIGN PATENT DOCUMENTS EXAMINER** INITIAL DOCUMENT NUMBER DATE COUNTRY CLASS SUB-CLASS **TRANSLATION** AJ1 WO 96/17480 A2&A3 06/1996 PCT N/A JP 3-161884 07/1991 JP No AK1 Yes AL1 No Yes AM1 No OTHER (Including Author, Title, Date, Pertinent Pages, etc.) International Search Report from PCT Appl. No. PCT/US03/38644, filed December 5, 2003, AN 1 3 pages. English Abstract for Japanese Patent Publication No. 3-161884, published July 7, 1991, 1 AO 1 page, from http://v3.espacenet.com/. McClurg et al., U.S. Patent Appl. No. 10/725,543, filed December 3, 2003, entitled "System Having a Rotating Optical System and a Non-Planar Prism that are Used to Obtain Print and ΑP 1 Other Hand Characteristic Information," 41 pages. AQ 1 AR 1 DATE CONSIDERED **EXAMINER EXAMINER:** Initial if reference considered, whether or not citation is in conformance with MPEP 609. Draw line through citation if not in conformance

and not considered. Include copy of this form with next communication to Applicant.

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	AA3		4,4	67,545	08/1984	s	haw, Jr.					
	AB3		4,5	78,793	03/1986	к	ane et al.					
<u> </u>	AC3		4,6	88,092	08/1987	K	amel <i>et al</i> .	-				
	AD3		4,701,960		10/1987	s	cott					
	AE3		4,7	20,869	01/1988	V	/adia					
	AF3		4,736,203		04/1988	s	idlauskas					
	AG3		4,7	36,436	04/1988	Y	asukawa <i>et al.</i>					
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	AA4		4,7	74,516 	09/1988		He	enri e <i>t al.</i>					
	AB4		4,7	90,025	12/1988		Inc	oúe et al.					
	AC4		4,8	05,117	02/1989		Fic	ore et al.	- ·				
	AD4		4,821,118		04/1989	04/1989		freniere					
	AE4		5,140,469		08/1992		La	marre et al.					
	AF4		5,225,924		07/1993		Og	gawa <i>et al.</i>					
	AG4		5,2	49,370	10/1993		Sta	anger et al.					
	AH4		5,3	07,264	04/1994		Wa	aggener et al.					
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	AA5		5,313,306	05/1994		uban <i>et al.</i>						
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	AC5		5,377,002	12/1994	M	alin et al.						
	AD5		5,440,428	08/1995	H	egg et al.						
	AE5		5,452,135	09/1995	М	aki <i>et al</i> .						
	AF5		5,469,289	11/1995	lw	/ao et al.						
	AG5		5,526,436	06/1996	Se	ekiya						
	AH5 5,528,355			06/1996	М	aase et al.						
	AI5		5,588,097	12/1996		no <i>et al.</i>						
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	AA6		5,6	10,751	03/199	97	Sw	veeney et al.						
	AB6		5,63	38,461	06/199	97	Frie	dge						
	AC6	. ;	5,6	50,842	07/199	97	Ма	ase et al.						
	AD6		5,677,782		10/199	97	Pe	ng						
	AE6		5,699,186		12/199	97	Ric	chard						
	AF6	!	5,7	77,751	07/199	98	Wa	ard						
	AG6		5,79	96,426	08/199	98	Gu	illichsen <i>et al</i> .						
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	AA7		6,03	38,332	03/2000	Fi	shbine et al.					
	AB7		6,04	41,134	03/2000	М	erjanian					
	AC7		6,04	46,867	04/2000	R	ana					
	AD7 6,175,407 B1		75,407 B1	01/2001	Sa	artor						
	AE7		6,19	98,429 B1	03/2001	Fı	ujikawa <i>et al.</i>					
	AF7		6,24	43,488 B1	06/2001	P	enna					
	AG7		6,3	41,028 B1	01/2002	В	ahuguna <i>et al.</i>					
	AH7 6,394,356 B1		94,356 B1	05/2002	Za	agami						
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	AA9		2004/0109245 A1	06/2004	Mo	cClurg et al.							
	AB9		2004/0109591 A1	06/2004		cClurg et al.							
	AC9		2004/0114785 A1	06/2004		cClurg et al.							
	AD9		2004/0114786 A1	06/2004	Ca	annon <i>et al.</i>							
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